



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/846,421	04/30/97	POPAT	G 310048-300CI

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IM71/1218

EXAMINER

BAHTA, A

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 12/18/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/846,421

Applicant(s)

Ghanshyam Popat

Examiner

Abraham BANTA

Group Art Unit

1774

☐ Responsive to communication(s) filed on 10/15/98

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-35 is/are pending in the application.

Of the above, claim(s) 28-35 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-27 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Election/Restriction

Applicant's election without traverse of October 15, 1998 in Paper No. 7 is acknowledged. Since Applicant election is without traverse it is requested that the non-elected claims now be canceled.

Claim Rejections - 35 U.S.C. § 112

Claims 1, 5, 11-14 and 20 24 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, 11-14 and 20 the term "substantial-cut lines" is not understood. Is 1/4 substantial? Is 1/2 substantial? What is substantial? The term "extending substantially" is indefinite as it is not known to what degree is extended. What is the difference between "substantially-cut lines" and "separation lines"? The Examiner understands cut-lines and separation lines require penetration.

In claim 5, 24 and 26 the term "more brittle" is indefinite. What is more? How more is more? Further the term "subjected" does not recite a positive limitation. Is the sheet brittle or not?

In claim 20, the term "easily and cleanly" are vague and indefinite. What is easy and what is clean or how easily or clean is it?

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Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishop et al (US Patent 5,571,587).

Bishop et al '587 disclose a sheet stock made of paper with a foil appearance, temperature resistant plastic and metallized or non-metallized film (col. 3, lines 9-15) which is adapted to be fed into a laser or ink jet printer and copying machine. See col. 1, lines 5-10. If desired, a second sheet of card stock or paper may be provided to provide rigidity. See col. 3 lines 43-45. The sheet comprise a plurality of perforation lines resulting in the formation of a plurality of substantially rectangular portions. See col. 4, lines 20-24.

Bishop et al do not specifically disclose that the sheet comprises substantial cut-lines.

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However, the reference at col. 4, lines 30-33 suggests that the perforation design is not limited to the illustrated embodiments such as in Fig.5 and that other varieties of perforation shapes may be employed depending on the type of printing job for which the sheet will be used. Thus, having suggested the above, it would have been obvious to one of ordinary skill in the art at the time of the invention was made, to include substantial cut-lines in order to manufacture the print media. Further, since perforations, weakened lines or cut lines require penetration of the print media to some depth or level, the skilled artisan would be capable to provide or employ the required depth on forming the cut-lines or weakened lines in order to facilitate separation of the print media into plurality of individual printed sheets or print media.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.2d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-4, 14-17 and 20-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 76-92 and 96-99 of copending Application No. 08/641,332. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4, 14-17 and 20-23 of the instant claimed application are the obvious products of the method claims recited in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Crystal Plaza 3 Fax Center

A facsimile center has been established in Crystal Plaza 3, 8th floor for Art Unit 1774. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 305-5408 or for official after final faxes (703) 305-3599. This new location should be used in all instances when facing any correspondence to Technology Center 1700, Art Unit 1774 Use of the new Crystal Plaza 3 center will facilitate rapid delivery of materials to Art Unit 1774. The facing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15 1989).

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Any inquiry concerning this communication should be directed to Abraham Bahta at telephone number (703) 308-4412. The Examiner can normally be reached Monday-Friday from 9:30 AM -6:00 PM (EST).


If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor Bill Krynski, can be reached on (703) 308-2376.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



A. Bahta

12/16/98



William Krynski
Supervisory Patent Examiner
Technology Center 1700